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In re Application of
Udo Bickers et al
Serial No.: 10/049,410
Filed: February 7, 2002
Attorney Docket No.: 514413-3911

: PETITION DECISION

This is in response to the petition under 37 CFR 1.181, filed October 17, 2005, requesting withdrawal of the Final rejection and reopening of prosecution.

BACKGROUND

A review of the file history shows that the examiner mailed a non-Final Office action to applicants on July 1, 2002, setting a three month shortened statutory period for reply. The Office action rejected claim 9 under 35 U.S.C. 112, second paragraph as indefinite and claims 10-12 were rejected as non-statutory under 35 U.S.C. 101. Claims 1-13 were also rejected under 35 U.S.C. 103(a) as unpatentable over Masayuki et al in view of Langley et al. Applicants replied on October 28, 2003, by amending claims 4-9, canceling claims 10-13 and adding claims 14-17 and responding to the rejections of record.

The examiner mailed a Final Office action to applicants on January 27, 2003, setting a three month shortened statutory period for reply. The examiner maintained the rejection of claims 1-9 under 35 U.S.C. 103(a) over Masayuki et al in view of Langley et al for reasons of record. The examiner indicated claims 14-17 as allowable. Applicants filed an amendment after Final rejection on May 19, 2003, amending claims 1 and 14 and responding to the rejection of record. The examiner denied entry of the amendment on June 18, 2003, and applicants filed a Notice of Appeal on August 1, 2003.

Applicants then filed a new amendment after Notice of Appeal on November 6, 2003, in which claims 1, 7 and 14 were amended and further argued the merits of the amended claims. The examiner mailed an Advisory action to applicants on January 7, 2004, indicating the amendment raised new issues and would not be entered. A third amendment after Final rejection was then filed on February 3, 2004, which canceled claims 1-9 and amended claim 14 and presented further argument.

The examiner mailed a new non-Final Office action to applicants on March 19, 2004, setting a three month shortened statutory period for reply. The examiner rejected claims 14-15 and 17

under 35 U.S.C. 102(b) as anticipated by Narayanan et al or Sanders, both newly cited, and indicated claim 16 as allowable. Applicants replied on June 24, 2004, making a minor amendment to claim 14 and replacing claim 16 with claim 18 and responding to the rejections.

The examiner mailed a Final Office action to applicants on September 9, 2004, setting a three month shortened statutory period for reply and maintaining the rejection of claims 14-15 and 17 under 35 U.S.C. 102(b) over Narayanan et al and Sanders. Claim 18 was indicated allowable.

Applicants replied on December 13, 2004, arguing the rejections of record. The examiner mailed an Advisory Action to applicants on January 10, 2005, noting the argument and that the paper would be entered, but did not place the application in condition for allowance. No further explanation was given. A Notice of Appeal was filed on February 14, 2005 and an Appeal Brief on April 13, 2005. The examiner mailed an Examiner's Answer to applicants on July 11, 2005.

This petition followed on October 17, 2005, and requests the Office to withdraw the Finality of the Office action inasmuch as a new ground of rejection is set forth in the Examiner's Answer in that previously allowed claim 18 is rejected for the first time.

DISCUSSION

It is noted that this petition was not filed within the two month time period allotted under 37 CFR 1.181(f). However, in view of the examiner's actions it will be considered on its merits.

The above review of the prosecution of this application shows that, as indicated by applicants, claims 18 was indicated as allowable in the Final Office action mailed September 9, 2004. The Appeal Brief clearly addresses the rejection of claims 14-15 and 17, noting that claim 18 has been indicated allowable. The Examiner's Answer, however, states that the copy of the claims appealed is correct and that the grounds of rejection as stated by applicants are correct. The examiner then goes on to restate the grounds of rejection, stating that claims 14-15 and 17 are rejected under 35 U.S.C. 102(b) as anticipated by Narayanan et al, relying on the abstract and teachings at column 2, line 64-column 4, line 47. Also that claims 14-15 and 17 are rejected under 35 U.S.C. 102(b) as anticipated by Sanders, relying on the abstract and column 2, line 36 to column 3, line 23. In the response to arguments section (part 11, page 4), the examiner states: "Upon reconsideration, claim 18 is added to Narayanan's 35 U.S.C. 102(b) rejection of record" and relies on the cited section, column 2, line 64 et al.

M.P.E.P. 1207 states, *inter alia*:

If the examiner's answer contains a new ground of rejection, it must give appellant a two-month time period to reply to the new ground of rejection. The answer must also include the signature of a Technology Center (TC) Director or designee to indicate that he or she approves the new ground of rejection. See MPEP § 1207.03 and form paragraph 12.179.01.

The rejection of a previously allowed claim in an Appeal Brief, even though the rejections is on the same grounds and over the same reference(s) and for the same reasons as set forth in a Final Office action must be considered a new ground of rejection. As noted above, such ground requires the signature of the Technology Center Director which was not here obtained. It also

requires that applicants be advised of the new ground of rejection and given an opportunity of not less than two months to reply thereto by filing either a Reply Brief or a request to reopen prosecution. No such advice was given in the Examiner's Answer.

The Examiner's Answer is defective in failing to indicate that a new ground of rejection has been set forth and in failing to obtain a signature of a Technology Center Director. In view of these defects the Examiner's Answer can only be considered a non-Final Office action containing a new ground of rejection not necessitated by applicants' amendments.

DECISION

The petition is **GRANTED**.

The Examiner's Answer is redesignated as a non-Final Office action. Applicants are given a THREE MONTH NON-EXTENDABLE TIME PERIOD from the date of mailing of this decision within which to reply to the action. No extension of time under 37 CFR 1.136(a) or (b) will be permitted. (The period is designated as non-extendable in view of the time elapsed within which applicants could have filed a Reply Brief or other paper responding to the merits of the new ground of rejection.) The arguments in the petition are not considered a response to the Office action.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.



Bruce M. Kisliuk
Director, Technology Center 1600